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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,068

01/26/2006

Alan Martin Birch

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ASTRAZENECA R&D BOSTON
35 GATEHOUSE DRIVE
WALTHAM, MA 02451-1215

EXAMINER

YOUNG, SHAWQUA

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

12/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,068	Applicant(s) BIRCH ET AL.	
	Examiner Shawquia Young	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 20-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 1,3-10,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/31/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 3-10 and 16-22 are currently pending in the instant application.

I. *Information Disclosure Statement*

The information disclosure statements (IDS) submitted on May 31, 2006 and May 2, 2007 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

II. *Response to Arguments*

Applicants' amendments and arguments, filed on October 15, 2007, have overcome the following rejection(s): the rejection of claims 1, 3-10 and 17 under 35 USC 112, first paragraph, as failing to comply with the written description requirement; the rejection of claims 1, 3-10 and 17 under 35 USC 112, first paragraph for scope of enablement; the rejection of claims 3-10 and 17 under 35 USC 112, second paragraph as being incomplete for omitting essential structural cooperative relationships of elements. The above rejections are withdrawn.

III. *Rejection(s)*

Claim Rejections - 35 USC § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-10, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph,

as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, there are brackets present in the definitions of the variables found in formula (1) in claims 1, 6, 7 and 18. Brackets should not be used in place of parenthesis because brackets are normally used to denote deleted subject matter. It is unclear whether Applicants are trying to delete the subject matter or the brackets are used in a similar way as parenthesis.

Claims 1, 3-10 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the term "saturated ring" is not defined in the specification to know the subject matter embraced by the term.

"Saturated ring" embraces both carbocyclic rings and heterocyclic rings.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. Claim 18 recites "A compound of the formula (I) wherein...." and the claim is an independent claim. However, claim 18 does not show the structure of formula (I) which is necessary for one to know what compound is being described.

IV. Objections

Claim Objections

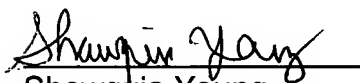
Claim 9 is objected to because of the following informalities: there is a parenthesis at the end of the claim that should not be there.

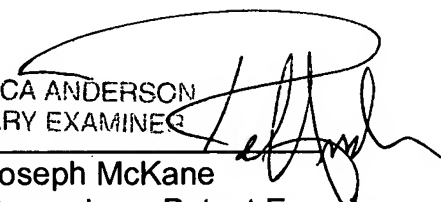
V. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 6:30 AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shawquia Young
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600


REBECCA ANDERSON
PRIMARY EXAMINER

Joseph McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600